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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/762,602 | 01/22/2004 | Werner Knebel | 5005.1068 | 5040 |
| 23280 | 7590 | 01/09/2006 | EXAMINER | |
| DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018 | | | ELLIS, SUEZU Y | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2878 | |

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,602

Applicant(s)

KNEBEL ET AL.

Examiner

Suezu Ellis

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-14 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☒ Claim(s) 1,3,6-10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

RESPONSE TO AMENDMENT

Claim Objections

Claims 1, 8 and 9 recite the limitations "the output light" in line 2 and "the measuring element" in line 6 (line 5 for claim 8). Claims 3 and 12 recite the limitation "the different wavelength regions" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 7 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 9 and 10, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Engelhardt.

With respect to claim 8, Engelhardt discloses in Fig. 3, a scanning microscope comprising an acoustooptical component (4) that splits illuminating light from a light

source (2), a control circuit (13) that controls the power of the illuminating light, a monitoring detector (power detector – 17) that is arranged in the beam path of the output light from which the illuminating light has been split out, and a processing module (22) that controls the acoustooptical component. Engelhardt discloses the readings from the monitoring detector are conveyed to a controlling element (21), thus is deemed equivalent to a measuring element of the control circuit [00023], [0024]. Engelhardt further discloses a control loop that can be a phase-locked loop, thus is either an open or closed loop [0027].

Allowable Subject Matter

Claims 1-7 and 9-14 are allowed.

With respect to claims 1 and 9, prior art fails to teach or reasonably suggest a scanning microscope having an acoustooptical component that splits out illuminating light for illumination of a sample from an output light from a light source and that conveys detected light proceeding from the sample to a detector, in addition to other limitations of the claim.

Claims not specifically addressed are allowable due to their dependency.

Response to Arguments

Applicant's arguments regarding claim 8 have been fully considered but they are not persuasive.

With respect to claim 8, Applicant argues the acoustooptical component fails to convey detected light proceeding from the sample to a detector. However, claim 8 fails to claim the acoustooptical component as functioning in such a manner. Applicant further argues that the monitoring detector (17) is disposed in the beam path of the illuminating light (5) that *has been* split from the light (1) rather than being disposed in the beam path of the output light *from which* the illuminating light has been split. Applicant fails to clearly define which beam path the monitor detector is arranged in. The beam path of the output light (1) from which the illuminating light has been split out (5) is interpreted as the beam path of the illuminating light (5). Note, the illuminating light can be interpreted as light beams 1 and 5, wherein light beam 1 is also the output light of the light source, and the acoustooptical component splits the illuminating light (1) into two output beam paths (5, 15), thus “the beam path from which the illuminating light has been split out” can be interpreted as either output beam (5, 15). Applicant fails to clearly distinguish between light beam paths 5 and 15.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone/Fax Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephone B. Allen
Primary Examiner